UNITED STATES PATENT AND TRADEMARK OFFICE

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3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _11 February 2005_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-28_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- No claims are amended.

- No claims are canceled.

- Claims 28 are added

- Claims 1-28 have been considered.

2.   Examiner withdraws rejection of claims 1, 19, 20, and 25 under 35 U.S.C 112-second paragraphs due to further clarification by applicant.

Response to Arguments

3.   Applicant's arguments filed 11 February 2005 have been fully considered but they are not persuasive. For the following reason;

As for the 101 rejections;

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These

exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds.

Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be

judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377.

Both of these analysis goes towards whether the claimed invention is non-statutory because of the

presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in

Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological

arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for

determining the year-end income, expense, and capital gain or loss for the portfolio) was already

determined to be within the technological arts under the *Toma* test. This dichotomy has been recently

acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection

finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669

(BdPatApp&Int 2001).

In the decision of *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1449-50 (Fed. Cir. 1999),

it was recognized that not everything is statutory subject matter. The court noted that a mathematical

algorithm or abstract idea is directed to non-statutory subject matter unless applied in a useful way or

otherwise reduced to some type of practical application. The analysis in the *AT&T Corp* decision focused

on whether or not the claimed mathematical algorithm was used to produce a useful, concrete and

tangible result. AT&T's claimed process employs subscribers' and call recipients' primary interexchange

carrier (PIC) indicator as data, applies Boolean algebra to those data to determine the value of the PIC

indicator, and applies that value through switching and recording mechanisms to create a signal useful for

billing purposes. The court noted that PIC indicator represents information about the call recipient's PIC,

a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXCs

subscriber, and therefore, found the claimed process to comfortably fall within the scope of Section 101.

AT&T Corp., 50 USPQ2d 1453. Again, *AT&T Corp.* never addressed the second part of the analysis, i.e.,

the "technological arts" test established in *Toma* because the court in *AT&T Corp.* recognized that the

claims require the use of switches and computers. In *AT&T Corp*, the decisions of *In re Alappat*, 33 F.3d

1526, 31 USPQ2d 1545 (Fed. Cir. 1994) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958

F.2d 1053, 1060, 22 USPQ2d 1033,1039 (Fed. Cir. 1992) were also cited. In *Alappat* it was held that

more than an abstract idea was claimed because the claimed invention as a whole was directed toward

forming a specific machine that produced the useful, concrete and tangible result of a smooth waveform

display. In *Alappat*, the claimed invention was for a machine that achieved certain results and was

therefore, already considered to involve the technological arts. In *Arrhythmia*, the court reasoned that the

method claims qualified as statutory subject matter by noting that the steps transformed physical,

electrical signals from one form into another form – a number representing a signal related to the patient's

heart activity, a non-abstract output.

This dichotomy has been recently acknowledged by the Board of Patent Appeals and

Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See

Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions

of *State Street, Alappat, Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use

of technology as shown below.

State Street: The claims were in means plus function form and directed to a data processing

system for managing a financial services configuration of a portfolio established as a partnership; the

claims included limitations of a computer processor means for processing data, a storage means for

storing data on a storage medium along with first through fifth means for processing different types of

financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and,

therefore, whether or not the claimed invention involved the technological arts was not an issue.

AT&T Corp: The claims were directed to a method for use in a telecommunications system in

which interexchange calls initiated by each subscriber are automatically routed over the facilities of a

particular one of a plurality of interexchange carriers associated with that subscriber comprising

generating a message record for an interexchange call between an originating subscriber and a

terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC)

indicator having a value which is a function of whether or not the interexchange carrier associated with

said terminating subscriber is a predetermined one of said interexchange carriers. In considering these

claims, it is clear that technology is being used to "automatically route" calls over the facilities of

interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Alappat: The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Arrhythmia: The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a

signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, in the present application, the claims are completely silent with regards to technology and are purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The claims are no more than a suggestion idea that user is provided with a proxy name and in order to hide the address from the merchant, the address for same user is replaced with other information (encrypting) and passing that information for further use by a shipper. The claims are completely devoid of any means to carry out a process implementing the idea of assigning the alias to the user as well as user's address by using technology.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

Therefore, the rejection of claims 1-19 and 25-27 under 35 U.S.C. 101as presented below are maintained.

As for 112 rejections;

The rejection of claims 1, 19, 20, and 25 under 112 second paragraph is withdrawn based on further clarification as well as pointing to an specific part of the specification to clarify the specifics of the claims.

As for rejections under 102 and 103;

Regarding the attempted disqualification of Zucker reference WO 99/66428 by the applicant, examiner would like to point out that it is an erroneous attempt by the applicant and the priority, which is claimed by the applicant in a very unorthodox manner has no legal or procedural bases or precedent in the manual of patent examining procedure (MPEP). Applicant has claimed priority by the mere fact of arguing in the background of the current application the statement "incorporates by reference application no. 09/360,812". Examiner would like to point out to the applicant that such incorporation by reference does not entitle the applicant to priority date of the incorporated application content. It only entitles the applicant to have the text of the referenced application be included in the current application. Nowhere in the first sentence or paragraph of the specification or data sheet of the current application is a reference to claiming priority to the application no. 09/360,812 for the purposes of claiming priority as such is required by the MPEP (See MPEP 37 CFR 1.78(a) and 37 CFR 1.76).

Therefore, the rejection under 35 U.S.C. 102 and 103 as presented below are maintained.

Claim Objections

4.   There were no responses to the objections made by the examiner in the previous office action by the applicant. Therefore, the objections are retained.

5.   Claim 10 is objected to because of the following informalities: examiner believes that instead of the "a shipper..." should be the shipper..."

6.   Claim 6 is objected to because of the following informalities: examiner believes that instead of the "generated for each transaction by the user" it should be "generated for each transaction for the user". It is not clear that user is able to generate such proxy name except to request such transaction. Appropriate correction is required.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   Claims 1-19 and 25-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2dat 1452.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10.   Claims 1-2, 6-7, 9-11, 13, 16-18, 20-21, and 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by Jeffrey M. Zucker et al. International Publication No. WO 99/66428.

11.   As per claims 1, 20, and 25, Zucker clearly teaches a method and system providing private shipping of items to users purchasing goods on a computer-based communications network comprising the steps of:

- providing a proxy identity (pseudo identity, pseudo name, or buyer ID) to a user (buyer)(See Zucker figure 12, page 9, lines 1-9);

- receiving a shipping address for the user (See Zucker figure 12, page 8, lines 18-28);

- partially encrypting the user's shipping address (See Zucker figure 13, page 10, lines 15-24 and page 23, lines 20-page 24, line 8);

- transmitting the proxy identity and encrypted shipping address to a merchant (seller) (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8); and

- providing decryption information to a shipper (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8);

- whereby upon receipt of the encrypted shipping address from the merchant, the shipper can use the decryption information to decrypt the address and generate a package label bearing the true shipping address of the user so that the merchant is prevented from electronically capturing the true identity of the user (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8).

12.   As per claims 2 and 26, Zucker teaches all the limitations of claims 1 and 25, further;

Zucker teaches the proxy identity comprises a proxy name and a proxy credit card account number (See Zucker page 10, lines 15-24).

13.   As per claim 6, Zucker teaches all the limitations of claim 2, further;

Zucker teaches a new proxy name (single-use buyer IDs) is generated for each transaction by the user (See Zucker page 9, lines 10-20).

14.   As per claims 7 and 27, Zucker teaches all the limitations of claims 1 and 25, further;

Zucker teaches the communications network is the Internet (See Zucker page 4, lines 16-18, and page 6, lines 20-22).

15.   As per claims 9, Zucker teaches all the limitations of claim 1, further;

Zucker teaches the encrypted shipping address contains sufficient information (actual city, state and zipcode) to allow the merchant to calculate an appropriate transaction tax (See Zucker page 10, lines 15-24).

16.   As per claim 10, Zucker teaches all the limitations of claim 1, further comprising:

maintaining a secure database of user transaction information; and providing access to the database to a shipper to resolve a shipping problem (pseudo payment information) (See Zucker page 24, lines 1-11).

17.   As per claim 11, Zucker teaches all the limitations of claim 10, further;

Zucker teaches the transaction information includes instructions for returning undeliverable items (See Zuker page 15, line 18-page 17, line 15).

18.   As per claims 13 and 21, Zucker teaches all the limitations of claims 1 and 20, further comprising generating a unique shopping session identification number (reference number) (See Zucker figure 13, page 11, lines 19-22 and page 13, lines 5-23).

19.   As per claims 16 and 24, Zucker teaches all the limitations of claims 1 and 20, further;

Zucker teaches the encrypted shipping address includes an index number (reference number) for cross-reference to a database of real shipping addresses (See Zucker page 14, lines 10-16).

20.   As per claim 17, Zucker teaches all the limitations of claim 1, further comprising randomly inserting at least one atypical textual character into the true shipping address before encrypting the shipping address (See Zucker page 10, lines 15-20, where buyer ID corresponds to one atypical textual character added to the shipping address and buyer ID is random as recited in line 19).

21.   As per claim 18, Zucker teaches all the limitations of claim 1, further comprising:

receiving a privacy level selection (Privacy preference) from the user for a shipment; and selecting an encryption algorithm for the user's shipping address based upon the selected privacy level (See Zucker page 8, lines 19-28).

22.   Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of

the teachings in the art and are applied to the specific limitations within the individual claim, other

passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

response, to consider fully the entire references as potentially teaching all or part of the claimed

invention, as well as the context of the passage as taught by the prior arts or disclosed by the

examiner.

Claim Rejections - 35 USC § 103

23.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

24.   Claims 12, 14-15, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

International Publication No. WO 99/66428 to Jeffrey M. Zucker et al.

25.   As per claim 12, Zucker teaches all the limitations of claim 1, further;

What Zucker is not explicit on teaching the user's encrypted shipping address contains an

identifier that may be used as an electronic mail address to contact the user (See Zucker page 8, lines

19-28).

However, Zucker clearly teaches the availability of such identifier (email address) to be forwarded

along with the physical address to a shipper or any other entity for contact purposes. It would also be

clear to preserve the privacy the email address would be encrypted along with the actual address.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the

current invention was made to encrypt the email address along with the physical address for the

motivation of preserving the privacy and preventing merchants from accessing such information.

26.   As per claims 14-15 and 22-23, Zucker teaches all the limitations of claims 1, 13 and 20, 21, further;

Zucker teaches the encrypting of the shipping address.

Zucker is not explicit on that the encrypting of the address is a function of the shopping session identification number (reference number) or a function of time (See Zuker page 10, lines 19-20 and page 14, lines 10-16, and page 23, lines 21-page 24, line 11).

However, the above method of encryption, as to use a session ID as a functional of the encrypted data for further ensuring of the authenticity and integrity of the content of the encrypted data is well recognized. Also, time stamping or encryption based on a function of time is an essential part of encryption methods recognized in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to include the encryption of the shipping address as function of the session ID (reference number) as well as time for the motivation of further control over the data integrity as well as superior encryption of the data.

27.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 99/66428 to Jeffrey M. Zucker et al. in view of U.S. Patent No. 5,903,652 to Amit Mital.

28.   As per claim 19 and 28, Zucker clearly teaches a method for providing private shipping of items to users purchasing goods on a computer-based communications network comprising the steps of:

- providing a proxy identity to a user, receiving a shipping address for the user; partially encrypting the user's shipping address;

- transmitting the proxy identity and encrypted shipping address to a merchant; whereby upon receipt of the encrypted shipping address from the merchant, the shipper can ,generate a package label bearing the partially encrypted mailing address of the user with the post office

What Zucker is not explicit on is the appending a post office box number to the user's encrypted shipping address.

However, Mital clearly teaches that additional shipping information (P.O.Box number) maybe added by other entities (Third party system). It is also a recognized practice in the industry to substitute an actual address with a P. O .Box number as drop ship location for protection of privacy, examples are postal locations, Western Union offices, or Mail Box Etc. locations.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to add additional information such as a P.O.Box number to an obfuscated address for the motivation of further protecting the privacy of a user of the system.

29.   Claims 3-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 99/66428 to Jeffrey M. Zucker et al. in view of U.S. Patent Application Publication No. 2001/0011247 A1 to Kenneth W. O'Flaherty.

30.   As per claim 3, Zucker teaches all the limitations of claim2, further;

Zucker does not explicitly teach the step of issuing a proxy identity includes issuing a physical integrated circuit card to the user.

However, O'Flaherty clearly teaches the issuing of "Privacy Card" (See O'Flaherty figure 5, page 7, [0093]-[0095]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Zucker and O'Flaherty to issue a smart card that is containing the information regarding the privacy information of the user for the motivation of portability as well as versatility of control access via the smart card in use along with data warehouses.

31.   As per claim 4, Zucker teaches all the limitations of claim 3, further comprising the step of authenticating (matching buyer ID with a password) the user's proxy identity (See Zucker page 8, lines 19-28).

32.   As per claim 5, Zucker teaches all the limitations of claim 4, further;

Zucker clearly teaches the step of authenticating the proxy identity.

What Zucker is not explicit about is authentication includes reading the integrated circuit card via a card reader.

However, O'Flaherty clearly teaches that such process of card reader authenticate such proxy identity (unique customer identification)(See O'Flaherty page 8, [0098], [0102]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the authentication method of the Zucker with that of O'Flaherty for the motivation of better protection against un-authorized use of a portable device containing personal and privacy information.

33.   As per claim 8, Zucker teaches all the limitations of claim 1, further;

Zucker teaches the user's proxy identity is available to a user.

What is not explicitly taught by Zucker is such proxy identity is stored in a digital wallet.

However, O'Flaherty clearly teaches that such proxy is stored in a smart card (electronic wallet)(See O'Flaherty page 7, [0093]-[0095] and page 8, [0098], [0102])

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to take advantage of the teachings of O'Flaherty in combination with teachings of Zucker as to store information in a digital wallet for the motivation of the security, portability as well as access control of the user over the information in such digital container be it virtual or actual.

34.   Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

35.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be

reached on 9 AM to 5:00 PM.

36.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where

this application or proceeding is assigned is 703-872-9306.

37.   Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)

at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202

K. Abdi
Examiner

September 15, 2004

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600